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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/421,213	10/20/99	O'BRIEN T	D6064CIP

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HM22/0510

EXAMINER	
HARRIS, A	
ART UNIT	**PAPER NUMBER**
1642	8

DATE MAILED: 05/10/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/421,213	O'Brien And Tanimot
Examiner	**Group Art Unit**
Alana M. Harris, Ph. D.	1642

☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-52 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-52 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-9, 16, 17, 49 and 50, drawn to an polynucleotide and a composition comprising the said polynucleotide, classified in class 536, subclass 23.1.

II. Claims 10, 11 and 46-48, drawn to an isolated and purified TADG-15 protein, classified in class 530, subclass 350.

III. Claims 12-15 and 32-35, drawn to a method for detecting TADG-15 mRNA and a kit for said method, classified in class 435, subclass 6. Claims 32-35 will be examined with Group III to the extent they read on a hybridization assay.

IV. Claims 18-21 and 32-35, drawn to a method of detecting TADG-15 protein and a kit for said method, classified in class 435, subclass 7.1. Claims 32-35 will be examined with Group III to the extent they read on detecting a protein.

V. Claim 22, 23 and 24, drawn to an antibody, classified in class 530, subclass 387.1.

VI. Claim 25, drawn to a method of screening for compounds that inhibit TADG-15, classified in class 435, subclass 7.4.

VII. Claim 26, drawn to a method of inhibiting expression of TADG-15 in a cell, comprising introducing a vector into said cell, classified in class 435, subclass 455.

VIII. Claim 27, drawn to a method of inhibiting a TADG-15 protein in a cell, comprising introducing an antibody into said cell, classified in class 435, subclass 344.1.

IX. Claims 28-31, drawn to a method of targeted therapy to an individual, classified in class 424, subclass 130.1.

X. Claims 36-39, drawn to a method of vaccinating an individual, classified in class 514, subclass 2.

XI. Claims 40-45, drawn to a method of producing immune-activated cells, classified in class 435, subclass 325.

XII. Claims 51 and 52, drawn to a method of treating a neoplastic state, classified in class 514, subclass 44.

2. The inventions are distinct, each from the other because of the following reasons:

Groups I, II and V are structurally and functionally different products which are made by different methods and have different uses. The examination of all groups would require different searches in the U.S. Patent Shoes and the scientific literature and would require the consideration of different patentability issues.

The methods of Groups III, IV and VI-XII differ in the method objectives, method steps and parameters and in the reagents used.

Inventions of Group I and Groups III, VII and XII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that

product (M.P.E.P. § 806.05(h)). In the instant case the polynucleotide of Group I can be used in any one of method groups III, VII and XII.

Inventions of Group II and Groups VI and XI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the isolated polypeptide of Group II can be used in any one method groups VI and XI.

Inventions of Group V and Groups IV, VIII and IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the antibody of Group V can be used in any one method groups IV, VIII and IX.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Attempts to reach Benjamin Aaron Adler by telephone on April 25, 2000 to request an oral election to the above restriction requirement were unsuccessful.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris, whose telephone number is (703) 306-5880.

NANCY A. JOHNSON, PH.D
PRIMARY EXAMINER